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09/644,656	08/24/2000	Matthew W. Kay	3011-02C	2964

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EXAMINER

NALEVANKO, CHRISTOPHER R

ART UNIT PAPER NUMBER

2611

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/644,656

Applicant(s)

KAY ET AL.

Examiner

Christopher R Nalevanko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 29-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/01/2004 have been fully considered but they are not persuasive.

Applicant argues that "Kitsukawa does not teach or suggest a product being available for purchase via the Kitsukawa broadcast network. Rather, a user must either visit a physical retail location or use an electronic system distinct from Kitsukawa's network, to purchase a product about which information and/or a coupon is displayed through Kitsukawa's network" (page 10 lines 9-13). Examiner asserts that Kitsukawa clearly shows that the information is associated with "at least one product available for purchase via the network." Kitsukawa shows the ability the link to the merchandise retailer or dealer for an electronic order (col. 12 lines 1-20, col. 13 lines 23-32, electronic link established with retailer so user can electronically order and purchase merchandise). Kitsukawa clearly shows this is done with an "electronic link," which is a network.

Applicant further argues that "The reference does not teach or suggest that the advertising information be received only if tuned to a particular channel. In fact, portions of the Examiner-cited text actually teaches against that recited in the claims...Kitsukawa teaches 'advertising information is received along with broadcasts of associated television programs.' Thus advertising information for multiple programs is received at the same time" (page 11 lines 7-12). Kitsukawa clearly shows that the advertising information may be received simultaneously with the scenes in which the identified items appear (col. 6 lines 50-65, col. 10 lines 50-60). Since a scene is viewed only when the

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correct channel is tuned, the associated information is only received when that particular channel is tuned.

Applicant's arguments regarding claims 32, 42, and 51 pertaining to the official notice statement have been addressed with the 103 rejection incorporating Hendricks et al (5,990,927). Although this does change the rejection, the Examiner has only modified the rejection to support the official notice statement and it does not have any affect on the finality of the rejection.

Regarding claims 37 and 46, Applicant additionally argues that "Hendricks does not teach [sic] suggest the on-demand advertising associated with a program disclosed in Kitsukawa. Further, Hendricks does not teach or suggest the ability to purchase products via a broadcast network, as disclosed and recited in the amended claims of the present application. Neither Kitsukawa nor Hendricks provides any motivation to make the combination put fort by the Examiner. Furhter, the Examiner has provided no guidance whatsoever as to how one could possibly make such combination" (pages 12-13 lines 16-22, 1-2). First, Hendricks is not used to show purchasing products via a broadcast, that is shown by Kitsukawa and discussed above. Hendricks is merely used to show that it is well known and expected in the art to implement user preferences for selecting information, which Hendricks clearly shows (col. 34 lines 52-67, col. 35 lines 1-30, personal profile to select a content that a user would be interested in). Also, even though Hendricks is not relied on to show ordering items via a network, this aspect is included in the specification (col. 31 lines33-40, ordering airline tickets through set-top box). Finally, in response to applicant's argument that there is no suggestion to combine the

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references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, because Kitsukawa already shows a user preferences ability in the operation of the system, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kitsukawa with the ability to send commerce information relating to a user's preferences as in Hendricks so that the user would be presented with the most relevant and personalized advertisements and products as possible. This would enhance the viewing experience as well as provide manufacturers the best chance to sell their products.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 29-31, 33-36, 38-41, 43-45, and 47-50 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Kitsukawa et al.

Regarding Claim 29, Kitsukawa shows a broadcast programming network device, comprising a tuner configured to tune to any one of multiple broadcast video programming reception channels to receive broadcast video programming scheduled on the one of the multiple reception channels to which the tuner is tuned (col. 5 lines 17-30, col. 6 lines 19-40, fig. 3 item 21) and icon related data indicative of the availability of commerce related information (col. 6 lines 25-67, col. 7 lines 10-20), a processor configured to process the received icon related data and to direct a simultaneous display of an icon with a display of the scheduled broadcast video programming (col. 7 lines 1-40, figs. 1 and 3), and a display screen configured to display the scheduled broadcast video programming and, in accordance with the directive, to simultaneously display the icon (col. 4 lines 39-50, col. 7 lines 21-40). Kitsukawa shows the ability the link to the merchandise retailer or dealer for an electronic order (col. 12 lines 1-20, col. 13 lines 23-32, electronic link established with retailer so user can electronically order and purchase merchandise). Kitsukawa clearly shows this is done with an "electronic link," which is a network.

Regarding Claim 30, Kitsukawa shows that the tuner is further configured to receive the available commerce information if tuned to the one channel (col. 2 lines 20-33, col. 5 lines 17-30, col. 6 lines 40-55). Kitsukawa also shows the processor is further configured to process the received available commerce information and to direct a simultaneous display of the received available commerce information with the display of the scheduled broadcast video programming (col. 6 lines 20-67, col. 7 lines 1-40), and wherein the display screen is further configured, in accordance with the directive, to

simultaneously display the received available commerce information with the display of the scheduled broadcast programming (col. 8 lines 20-67).

Regarding Claim 31, Kitsukawa shows a controller configured to enter a user input associated with the icon, wherein the processor directs the simultaneous display of the received available commerce information with the display of the scheduled broadcast video programming based on the user input (col. 2 lines 49-67).

Regarding Claim 33, Kitsukawa shows that the available commerce information is associated with the scheduled video programming (col. 2 lines 35-67).

Regarding Claim 34, Kitsukawa shows an IRD, or set top box, that houses a processor and tuner (fig. 2, col. 5 lines 1-55).

Regarding Claim 35, Kitsukawa shows that the commerce related information is information regarding a product and the purchase of the product (col. 2 lines 20-47, col. 6 lines 40-67, col. 8 lines 35-67).

Regarding Claim 36, Kitsukawa shows the commerce related information includes a listing identifying a plurality of products (col. 9 lines 12-33).

Regarding Claim 38, Kitsukawa shows that the processor directs the simultaneous display of the icon by triggering the display of the icon on the screen based on the icon related data so as to be simultaneous with a display of a predetermined portion of the scheduled video programming on the screen (col. 2 lines 35-61, col. 6 lines 40-67, col. 7 lines 10-20).

Regarding Claim 39, Kitsukawa shows a method for receiving commerce related information over a broadcast programming network comprising tuning to one of multiple

selectable broadcast video programming reception channels (col. 5 lines 17-30, col. 6 lines 19-40, fig. 3 item 21), receiving, responsive to being tuned to the one channel, broadcast video programming scheduled on the one channel and icon related data indicative of the availability of commerce related information (col. 6 lines 25-67, col. 7 lines 10-20), processing the received icon related data to generate an instruction directing a display of an icon simultaneous with a display of the scheduled broadcast video programming (col. 7 lines 1-40, figs. 1 and 3), and simultaneously displaying the scheduled broadcast video programming and the icon in accordance with the generated instruction (col. 4 lines 39-50, col. 7 lines 21-40). Kitsukawa shows the ability the link to the merchandise retailer or dealer for an electronic order (col. 12 lines 1-20, col. 13 lines 23-32, electronic link established with retailer so user can electronically order and purchase merchandise). Kitsukawa clearly shows this is done with an "electronic link," which is a network.

Regarding Claim 40, Kitsukawa shows that the instruction is a first instruction, and further comprising receiving the available commerce information, responsive to being tuned to the one channel (col. 2 lines 20-33, col. 5 lines 17-30, col. 6 lines 40-55), processing the received available commerce information to generate a second instruction directing a simultaneous display of the received available commerce information with the display of the scheduled broadcast video programming (col. 6 lines 20-67, col. 7 lines 1-40), and simultaneously displaying the received available commerce information with the received scheduled broadcast video programming in accordance with the second instruction (col. 8 lines 20-67). Although Kitsukawa doesn't specifically state an



“instruction” by the processor, it is nonetheless inherent that, since the system is controlled by a processor, the actions preformed by the system are under control of the processor instructions.

Regarding Claim 41, Kitsukawa shows receiving a user input associated with the icon, wherein the received available commerce information is processed to generate the second instruction based on the receipt of the user input (col. 2 lines 35-67). Although Kitsukawa doesn't specifically state an “instruction” by the processor, it is nonetheless inherent that, since the system is controlled by a processor, the actions preformed by the system are under control of the processor instructions.

Regarding Claim 43, Kitsukawa shows that the available commerce information is associated with the scheduled video programming (col. 2 lines 35-67).

Regarding Claim 44, Kitsukawa shows that the commerce related information is information regarding a product and the purchase of the product (col. 2 lines 20-47, col. 6 lines 40-67, col. 8 lines 35-67).

Regarding Claim 45, Kitsukawa shows the commerce related information includes a listing identifying a plurality of products (col. 9 lines 12-33).

Regarding Claim 47, Kitsukawa shows that processing the icon related data triggers the display of the icon so as to be simultaneous with a display of a predetermined portion of the scheduled video programming on the screen (col. 2 lines 35-61, col. 6 lines 40-67, col. 7 lines 10-20). Although Kitsukawa doesn't specifically state an “instruction” by the processor, it is nonetheless inherent that, since the system is controlled by a

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processor, the actions preformed by the system are under control of the processor instruction.

Regarding Claim 48, Kitsukawa shows broadcasting a first video programming and first icon related data indicative of the availability of first commerce related information (col. 5 lines 29-55, col. 6 lines 20-67), and to broadcast a second video programming and second icon related data indicative of the availability of second commerce related information (col. 5 lines 29-55, col. 6 lines 20-67, col. 8 lines 20-67). Kitsukawa shows the use of a broadcast satellite system, which is inherently connected to a central broadcasting station (col. 5 lines 1-27). This station is necessary to uplink the desired programming material to the satellite for downstream distribution to receiving devices. Furthermore, Kitsukawa shows the ability to send numerous icons relating to plurality of commerce available items that are shown on the display screen (col. 6 lines 40-65, col. 7 lines 1-60). Also, Kitsukawa shows a reception station, or receiving device, configured to tune to any of a first broadcast programming reception channel and a second broadcast video programming reception channel and, if tuned to the first channel, to receive the first video programming and the first icon related data and simultaneously display a portion of the scheduled first broadcast programming and an icon in accordance with the first icon related data (figs. 1-3, col. 5 lines 20-67, col. 6 lines 1-55). Finally, Kitsukawa shows that, if tuned to the second channel, the receiving device receives the second video programming and second icon related data and simultanesouly displays the icon data and programming data (figs. 1-3, col. 5 lines 20-67, col. 6 lines 1-55). Kitsukawa demonstrates the ability to show icon related data, as well as commerce data

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relating to that icon, pertaining to any commerce related object that is currently being broadcast on the selected broadcast channel's programming material (col. 2 lines 20-60, col. 6 lines 20-60). Kitsukawa also shows the ability the link to the merchandise retailer or dealer for an electronic order (col. 12 lines 1-20, col. 13 lines 23-32, electronic link established with retailer so user can electronically order and purchase merchandise).

Kitsukawa clearly shows this is done with an "electronic link," which is a network.

Regarding Claim 49, Kitsukawa shows broadcasting the available first commerce related data and second commerce related data (col. 5 lines 29-55, col. 8 lines 57-67, col. 9 lines 1-67). As stated above, Kitsukawa shows the use of a broadcast satellite system, which is inherently connected to a central broadcasting station (col. 5 lines 1-27). This station is necessary to uplink the desired programming material to the satellite for downstream distribution to receiving devices. Furthermore, Kitsukawa shows the ability to send a plurality of commerce related data pertaining to the available items that are shown on the display screen (col. 6 lines 40-65, col. 7 lines 1-60). Kitsukawa also shows the reception station is configured to receive the first commerce related information and simultaneously display the information with a portion of the first video programming if tuned to a first channel (figs. 1-3, col. 5 lines 20-67, col. 6 lines 1-55). Finally, Kitsukawa shows receiving the second commerce related information and simultaneously displaying the second commerce data with a second video program if tuned to a second channel (figs. 1-3, col. 5 lines 20-67, col. 6 lines 1-55). As stated above, Kitsukawa demonstrates the ability to show icon related data, as well as commerce data relating to that icon, pertaining to any commerce related object that is currently being broadcast on

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the tuned broadcast channel's programming material (col. 2 lines 20-60, col. 6 lines 20-60).

Regarding Claim 50, Kitsukawa shows a controller configured to enter a user input associated with the icon, wherein the reception system simultaneously displays the received available commerce information with the display of the scheduled broadcast video programming based on the user input (col. 2 lines 49-67).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 32, 37, 42, 46, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al in further view of Hendricks et al (5,990,927).

Regarding Claim 32, Kitsukawa shows that the icon data and commerce related information may be received separately from the broadcast data (col. 2 lines 25-35).

Kitsukawa further shows that the commerce related data must be demultiplexed from the broadcast data, suggesting that the commerce information is sent on a different frequency (col. 5 lines 19-55). Kitsukawa fails to show that the commerce and icon data are sent on an out-of-band path. Hendricks shows the ability to send additional data over an out-of-band channel (col. 36 lines 39-56, graphics of promotional channel sent out-of-band

frequency). This allows supplemental information to be sent without using the bandwidth of the broadcasting channels. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kitsukawa with the ability to send the commerce and icon information over an out-of-band channel, as shown in Hendricks, so that additional downstream bandwidth was not taken away from the broadcasting channels.

Regarding Claim 37, Kitsukawa shows the user of user preferences and settings regarding the systems operation, but fails to specifically state corresponding commerce information to the user's profile. Hendricks shows that the commerce information, or advertisement information, corresponds to a user's preferences (col. 34 lines 52-67, col. 35 lines 1-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kitsukawa with the ability to send commerce information relating to a user's preferences as in Hendricks so that the user would be presented with the most relevant and personalized advertisements and products as possible. This would enhance the viewing experience as well as provide manufacturers the best chance to sell their products.

Regarding Claim 42, the limitations of the claim have been discussed with regards to Claim 32.

Regarding Claim 46, the limitations of the claim have been discussed with regards to Claim 37.

Regarding Claim 51, the limitations of the claim have been discussed with regards to Claim 32.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 571-272-7299. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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